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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 08/354,726 | 12/06/94 | SOUDA | S 42327 |

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EXAMINER

FAN, J

ART UNIT

1203

PAPER NUMBER

17

DATE MAILED:

10/07/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/354,726

Applicant(s)
Souda et al.

Examiner
Jane Fan

Group Art Unit
1203



☒ Responsive to communication(s) filed on Jul 15, 1997

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 18 and 19 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 18 and 19 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 14

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1203

Claims 18-19 are again rejected under 35 USC 103 as being unpatentable over EP 074,341 in view of EP 198,20 for reasons of record.. Applicants' remarks and data have been carefully considered, but are deemed unpersuasive for the following reasons:

1. The significant difference between the facts presented in *In re Magerlein* with respect to this case is that the intermediate in *In re Magerlein* could not be used in any other manner but to make the final product. In significant contrast, the claimed intermediate has other uses (treating gastric disorders) besides to be used to make the final product.

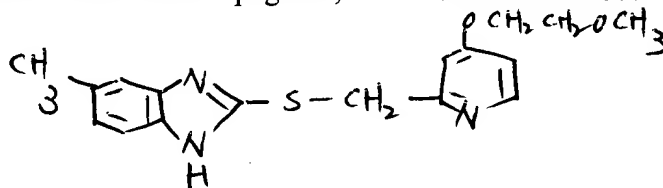
2. The data has been considered but are not convincing:

A. It does not have any probative value since it is not in declaration form.

B. It is not complete. There are only pages 13-17 stopped at the middle of the tests.

C. The compounds compared are not the closest compounds.

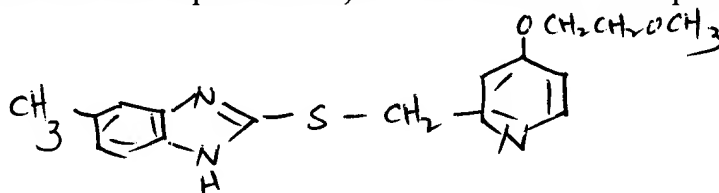
The art compound in EP 074341 page 20, ex. 27 should have been compared.



D. The unexpected advantage (antibiotic use) is not disclosed in the original specification. See *In re Davies*, 177 USPQ 381. If applicants disagree to this fact applicants are requested to point out the antecedent basis wherein antibiotic properties are disclosed in the specification by page number and line numbers.

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In order to overcome this rejection applicants are required to show unexpected advantages (disclosed in the specification) over the closest art compound.



Applicants allege that comparisons are not required since this claimed compound leads to unexpected advances of the final product. This remark is not well-taken since the unexpected advances of the final product already won a patent. Note patent 5,045,552.

Claims 18-19 are again rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 5,045,552 in view of GB 2,134,523. Note S and S are interchangeable for compounds of the same use in GB 2,134,523, page 1 left col. Line 48.

Applicants' remarks regarding the restriction requirement by the undersigned examiner on September 21, 1988 is not well-taken. A careful reading of the restriction requirement indicated that restriction was not based on n as alleged by applicants but based on X and Z variables.

Claims 18-19 are again provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claim of copending application Serial No. 08/679,473.

Claims 18-19 are again provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim of copending application Serial No. 08/679,473.

Art Unit: 1203

Applicants' terminal disclaimer filed on August 18, 1997 is not proper and has not been accepted for the following reason: Attorney not of record in oath /decl. or a separate paper filed appointing a new or associate attorney. Applicants need P.O.A or complete certificate . See 37 CFR 3.73(b).


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JANE FAN whose telephone number is (703) 308-4705.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

JTF October 2, 1997


JANE FAN
PRIMARY EXAMINER
GROUP 1200